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Paper No. 5

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In re Application of
Nguyen, et al.
Application No.: 09/930,694
Filed: August 15, 2001
Attorney Docket No.: 01-182

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OFFICE OF PETITIONS

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.137(b)

This is in response to the "Petition to Revive under 37 CFR 1.137(b)" filed May 16, 2003.

The petition is granted.

The petition includes a copy of the "Request to Rescind Previous Nonpublication Request," signed July 29, 2002, and received by the Office on August 5, 2002. Petitioner argues that the request to rescind should be treated as a notification of foreign filing in which case the application would not be abandoned. Petitioner further argues that the filing of an international application in the PCT Receiving Office should be construed as sufficient notice to the Director of the filing of foreign application. In the alternative, petitioner requests that the petition be treated under 37 CFR 1.137(b).

Title 35, Section 122(b)(2)(b) of the United States Code provides:

- (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication shall not be published as provided in paragraph (1).
- (ii) An applicant may rescind a request made under clause (i) at any time.
- (iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multi-lateral international agreement specified in clause (i), an application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

Title 37, Section 1.213 of the Code of Federal Regulations implements the provisions of 35 U.S.C 122(b)(2)(B).

Most patent applications filed on, or after, November 29, 2000, will be published, unless applicant files a request for nonpublication in compliance with 37 CFR 1.213(a). A nonpublication request is required to contain a certification that "the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement that requires publication at eighteen months after filing." Applicants who do not plan to file in another country are not required to file such a certification, and given that provisional rights may be available to those who have their patent applications published, some applicants who do not plan to file in another country may elect to

have their applicant published to be eligible for provisional rights. As a result, the filing of a rescission of a nonpublication request does not imply that the invention has been, or will be, filed in another country, and instead suggests that the applicant now desires to have the application published in the United States.

Further, 35 U.S.C. 122(b)(2)(B)(ii) addresses rescission. If all rescissions provided notice of foreign filing, then 35 U.S.C. 122(b)(2)(B)(ii), which requires applicants to provide notice of foreign filing within a set time period, would have provided that the “rescission specified in clause (ii) must be filed no later than 45 days after the date of foreign filing.” Instead, clause (iii) merely specified that “applicant who has made a request under clause (i) . . . shall notify the Director if such filing no later than 45 days after the date of such filing” and does not itself require such an applicant to rescind the nonpublication request. Implicit in providing notice of foreign filing a rescission of the nonpublication request, but not *vice versa*. Thus, the statute clearly identifies rescission of the nonpublication request and notification of a foreign filing as two separate acts, and a rescission alone cannot be construed as notice of foreign filing.

Petitioner’s arguments that no specific notice is required and that filing of an international application in the United States receiving Office was a notification of foreign filing are similarly not persuasive. Title 37, Section 1.213(c) of the Code of Federal regulations requires the applicant to provide notice, and 37 CFR 1.4(b) provides that each applicant must be complete in itself. An international application would not be placed into the file of application that it relies upon for the benefit of an earlier filing date, and so petitioner was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified applicant. Accordingly, the mere filing of a PCT application is not the notification required by 35 U.S.C. 122(b)(2)(B)(ii) and 37 CFR 1.213(c). Petitioner’s attention is also directed to 37 CFR 1.4(c), which states:

Since different matters may be considered by different branches or section of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject, so notification of foreign filing was required to be on a separate paper from another matter (such as a new application). Thus, filing a copy of the international application in the above-identified application would not have been notice of foreign filing.

On July 30, 2002, a PCT application No. PCT/US02/24005 was filed. A review of the content of the above-cited application did not reveal a notification of the filing of the PCT application, other than that filed with the instant petition. As a result of petitioner’s failure to provide timely notice of the filing of the PCT application, the above-identified application is abandoned.

A petition to revive an applicant abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(ii) for failure to notify the Office of a foreign filing must be accompanied by:

- (1) notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

See 37 CFR 1.137(b) and (f).

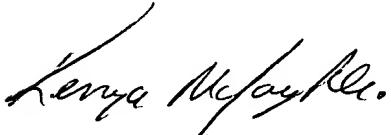
The statement in the instant petition “[a]pplicant hereby states that the entire delay in notifying the Office as in the Notice at Tab A of the international filing until the filing of this petition was unintentional” will be construed as meaning that “the entire delay in filing the required reply [the notification of the filing of the PCT application] until the filing of a grantable petition was unintentional.” Accordingly, the failure to timely notify the Office of a foreign or international

filing within 45 days as provided by U.S.C. 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

The rules and statutory provisions governing the operations of the U.S. patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. 41(a)(7). Accordingly, as authorized, the required \$1,300.00 petition has been charged to deposit account 13-2490.

Any inquiries concerning this decision may be addressed to the undersigned at (703)305-0010.

This application is being forwarded to the Office of Initial Patent Examination for further processing.



Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Corrected Filing Receipt